Doc

AF
EFW

PTO/SB/21 (09-04)
Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission: 35

Application Number	~~09/757,940~~ 09/757,206
Filing Date	January 10, 2001
First Named Inventor	R. Mark Halligan
Art Unit	3629
Examiner Name	Janice A. Mooneyham
Attorney Docket Number	7208-77901-1

ENCLOSURES *(Check all that apply)*

- ☐ Fee Transmittal Form
  - ☐ Fee Attached
- ☐ Amendment / Reply
  - ☐ After Final
  - ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Response to Missing Parts/ Incomplete Application
  - ☐ Reply to Missing Parts under 37 CFR 1.52 or 1.53
- ☐ Drawing(s)
- ☐ Licensing-related Papers
- ☐ Petition
- ☐ Petition to Convert to a Provisional Application
- ☐ Power of Attorney, Revocation Change of Correspondence Address
- ☐ Terminal Disclaimer
- ☐ Request for Refund
- ☐ CD, Number of CD(s) _____
  - ☐ Landscape Table on CD
- ☐ After Allowance Communication to TC
- ☐ Appeal Communication to Board of Appeals and Interferences
- ☐ Appeal Communication to TC **(Appeal Notice, Brief, Reply Brief)**
- ☐ Proprietary Information
- ☐ Status Letter
- ☒ Other Enclosure(s) (please identify below):

Reply Brief Under 37 C.F.R. 1.193(b)(1)

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Welsh & Katz, Ltd.		
Signature			
Printed name	Jon P. Christensen		
Date	June 25, 2007	Reg. No.	34,137

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria,VA 22313-1450 on the

Signature	Colleen Dunphy		
Typed or printed name	Colleen M. Dunphy	Date	June 25, 2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: R. Mark Halligan Art Unit: 3629

Serial No.: 09/757,206

Filed: January 10, 2001

For: METHOD AND APPARATUS FOR DOCUMENTATION, ANALYSIS, AUDITING, ACCOUNTING, PROTECTION, REGISTRATION, AND VERIFICATION OF TRADE SECRETS

Examiner: Mooneyham, J.

Attorney Docket No.: 77901-1

REPLY BRIEF UNDER 37 CRF §1.193(b)(1)

Mail Stop: Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the Examiner's Answer of April 25, 2007, applicant responds as follows.

With regard to the rejection of Claims 1-70 and 121 under 35 USC §112 first paragraph, the Examiner asserts that "there is no specific teaching [in] the disclosure that would allow one of ordinary skill in the art to develop a computer program that would in turn create/provide a predetermined criteria for evaluating a trade secret" (Examiner's Answer, page 6). First, Examiner's argument has expanded the claim language from "providing a predetermined criteria" to "create/provide a predetermined criteria". Examiner's argument for rejection on these grounds is thus inapposite to the claim language, and rejection on these

grounds should be overturned.

Moreover, a computer and computer program are an apparatus that performs some process. The very act of describing an automated process inherently describes the steps of the computer program that accomplishes that process.

Page 20, last full paragraph and Table C describe a process whereby a user uses the criteria of the six factors of Table C to evaluate a trade secret. Since Table C and associated paragraphs are described in clear, concise and concrete terms, so too is the content of the computer program that would accomplish the process of evaluating trade secrets using Table C. In addition, the specification clearly sets forth that the process is set within the context of the computer of FIG 1 of the specification. As such, at least one "means within the programmed computer for providing a predetermined criteria" is, in fact, disclosed.

The Examiner asserts that "claims 1, 119, 120, 121, 122, 123 all claim a form of calculating a metric from the received numerical score values, however . . . the means is simply an 'arithmetic processor' . . . There is no disclosure how this processor works or any formula used" (Examiner's Answer, page 6). On the other hand, arithmetic processors are well known in the art. Moreover, the specification does disclose formulae in the form of an average and a sixth root of a product (specification, page 24, first full paragraph). Moreover, Examiner admits the disclosure of

a formula in a later argument: "Examiner asserts the appellant's invention is nothing more than a mathematical formula used to provide a ranking...." (Examiner's Answer, page 54)

The Examiner suggests that the "means for characterizing (whether the trade secret constitutes negative know-how, whether the trade secrete is a combinational trade secret), means for specifying security measures, means for associating said security measures with a trade secret, means for specifying, means for determining which security measures are needed, means for specifying security threats, means for analyzing the ratio, means for specifying values for the six factors of a trade secret, means for determining employee exposure to a trade secret, means for characterizing employee exposure, means for characterizing security risk" are directed to new matter. However each of these terms is used within the specification and is described in the context of a process. For example, the entry of "negative know-how" and "combinational trade secret" data is discussed at page 17, second full paragraph. The entry of data regarding security measures, security risk, the association of security measures with trade secrets and the determination of which security measures are needed as well as the ratio of security measures to security threats are discussed in the specification beginning on page 17 and continuing to page 19 and are shown in FIG. 3. The entry of data values on a scale of 1 to 5 and a criterion for specifying values is provided on page 20, second full paragraph and Table C. The entry of data

regarding employee exposure and characterizing employee exposure on a scale of one to five is discussed beginning with the second full paragraph of page 27 and continues to page 28 of the specification. Moreover, means for entering such data are well known to those of skill in the art.

Moreover, "FIG. 1 illustrates a means for data processing, called a digital computer, connected to one or more means for entering the data and displaying the data" (specification, page 10, ninth full paragraph). Since the terms are described in the context of a process, the process inherently sets forth the programming content of the means-plus-function element that supports the use of each of the terms. As such, there is no new matter in claims 8-12, 14, 16-20, 23-31, 49-51, 53-56, 60, 62, 63, 67 and 69.

The reader's attention is now directed to the rejection of Claims 1-70 and 119-123 under 35 USC §112, first paragraph. Examiner asserts (Examiner's Answer, page 8) that "one skilled in the pertinent art could not make and use the appellant's invention without undue experimentation."

What is claimed in the independent claims is a method for aggregating six separate judgments for each trade secret (judgments which users skilled in the art of evaluating trade secrets generally know how to make) and then ranking the portfolio of trade secrets based on the aggregated score.

Applying the numeric values of 1 through 5 to the answers contained in the questionnaire of Table C of the specification (pages 20-22), as directed in the paragraphs on page 20 of the specification, calculating numeric values from the answers received from the user, and ranking the trade secrets on the basis of the resulting score for each trade secret defines the output for a specific embodiment of the invention.

Creating a system to perform these claim steps of the independent claims from the disclosure alone is a relatively simple exercise for one skilled in the art of computer programming, but a complete functional specification for a specific embodiment of the invention is included in Appendix I as further guidance.

The "such as" and "may be" language of the specification to which Examiner objects is used merely to incorporate other possible embodiments of the invention, in which, for example, rankings on the basis of 1 through 4 or 1 through 6 may be used.

Examiner's rejection for a lack of enablement to make the invention is therefore unsupported, is incorrect and should be overturned.

Examiner's argument in the Examiner's Answer for rejection for a lack of enablement to use the invention ultimately hinges on two main points: the alleged failure to provide sufficient guidance or direction on the 1 to 5 scale, and the subjective nature of the information input under the claimed invention in response to the predetermined criteria provided to the

user in the first claim step of each of the independent claims.

With regard to the first point, in the Examiner's Answer, "the Examiner asserts that the appellant does not provide sufficient guidance or direction as to the actual numerical scale being used in the invention or how the scale is to be applied" (Examiner's Answer, page 30). However, the 1 to 5 scale is well understood by the public at large, and even more so to those skilled in the art of evaluating trade secrets, who are either technical or legal people, including engineers, attorneys and judges. A Google search turns up 1.4 million web page hits for "1 to 5 scale", "scale of 1 to 5" and "scale from 1 to 5" using either the numerals 1 and 5 or the words 'one' and 'five'. Clearly, the 1 to 5 scale is in common use within the English language and is well understood by the public. No further guidance or direction is necessary.

Examiner states that "the scale of one to five has not been defined" (Examiner's Answer, page 37). Appellant disagrees, and asserts that a "scale of one to five" is common English usage and is all the definition that is required. The American Heritage Dictionary notes as one definition for "scale": "A progressive classification, as of size, amount, importance, or rank: *judging divers' performances on a scale of 1 to 10.*" Here the concept of a "one to n" scale is so assumed to be a common part of the language that it is used as an example to illustrate the definition.

Further on the one to five scale, Examiner states:

"Moreover, it is not that individuals have little trouble ranking items on a scale of one to five, it is the fact that the scale of one to five has not been defined. What defines a one or a two? What does a one or a five mean? How is the scale to be applied?" (Examiner's Answer, page 37). Appellant asserts that these statements are in conflict. If "individuals have little trouble ranking items on a scale of one to five", then those individuals must already know the definition of a one or a two, must already understand what a one or a five mean, and must already understand how to apply the scale, else they could not perform the ranking, on which Examiner admits they "have little trouble". The understanding of the one to five scale is common knowledge, to the point of being used in the dictionary to illustrate a definition, and requires no further definition from Appellant.

Finally, in Table C on page 20, Appellant provides as an example of predetermined criteria a sample questionnaire that includes five answers to each of the six factor questions on the questionnaire. These five answers provide further definition of the one to five scale, though it is clearly not needed for those skilled in the art to make use of the invention.

On the other hand, Table C inherently defines rankings on a scale of one to five and provides definitions for each ranking. For example, the specification explicitly states that "each trade secret may be characterized by a value, for example, a number on a scale of 1 to 5, using the descriptive labels and definitions

provided as a further example in Table C" (specification, page 20, lines 14-17). The first factor in Table C has the descriptive label "Inside Knowledge" followed by the question to be answered in evaluating the trade secret under the first factor (i.e., "To whom is the trade secret known in the company?"). Following the question to be evaluated under the first factor are five possible answers and a definition for each of the five answers. The first answer is "Whole Company" followed by the definition "Generally known within the company." The second answer is "Within Division" followed by the definition "Generally known within the originating division." The third answer is "Within Department" followed by the definition "Generally known within the originating department", the fourth answer is "Within Group" followed by the definition "generally known within the originating group", and the fifth answer is "Select Persons" followed by the definition "Known to select persons only." If a user should select the fifth answer, then the claimed system would assign the highest ranking on the scale of one to five for the factor. If the user should select the fourth answer, then the factor would receive the second highest ranking and so on.

Similarly, the second factor has the descriptive label "Outside Knowledge" followed by the question to be answered of "To whom is the trade secret known within the industry?" Following the descriptive label for the second factor are five possible answers. As with the first factor, each of the five possible answers for the

second factor has a definition associated with each answer. As with the first factor, selection of the first answer would receive the lowest possible ranking on the scale of one to five.

The third through sixth factors of a trade secret within Table C use the same process. In each case, the user selects an answer based upon the definition. In each case, the claimed system ranks the factor based upon the selection.

Table C provides five rankings and a definition for each ranking. As such, the ranking scale has been clearly defined in terms explicitly related to evaluating a trade secret. In addition, the criterion to be used for selecting a ranking for each factor of a trade secret is set forth in terms that are directly and explicitly related to the factor. As such, the ranking and criteria for determining a ranking is tangible, concrete and definite.

The second main point on which Examiner's argument rests is the subjective nature of the information input to the invention in response to the predetermined criteria provided to the user in the first claim step of each of the independent claims. This argument is not germane to the claimed invention, as the user's judgment lies outside of the clear language of the claims.

Quoting from the Examiner's Answer:

> "The Examiner is unclear how the appellant can make the statement that the selection of a user input is not part of the claimed invention. Representative claims 1 and 119-123 clearly claim providing a questionnaire of six multiple-choice questions, providing a numerical score value to each of the

> possible responses on the questionnaire, accepting responses through the input device in response to the questionnaire, converting the individual responses received to the numerical score values, calculating a metric from the numerical score values, and ranking the trade secrets in order of the calculated metric. Thus, the Examiner asserts that the user's judgment with respect to the six necessary component variables is the input." (Examiner's Answer, page 36)

The Examiner is exactly correct that the user's judgment with respect to the six necessary component variables is the input. The process of the user determining the input to the invention thus lies outside the scope of the invention. The claim language could not be more clear. Logically, if the user's judgment is the input to the invention, as Examiner admits, then the user's process in coming to that judgment must by definition lie outside the scope of the invention. That is, if the user comes to a judgment, and inputs that judgment into the invention, coming to that judgment lies outside of the invention or it would not need to be input.

Applying Examiner's argument to other devices in common use is instructive. A new type of remote control for televisions, a new type of numeric calculator, and a new type of GPS-based guidance system would all fail Examiner's test for patentability under this argument. Each of these devices requires user input to determine the output. Those inputs are subjective based on the judgment of the user. The output depends on the input in such a way as to render the output indeterminate if the user's subjective determination of the desired input is included in the scope of the invention.

What each of these devices does is perform a well-defined action in response to an input. The determination of the input itself lies outside of the scope of the invention.

The analogy is exact. The user of Appellant's invention desires that an aggregation of his own (or another's) subjective input to the method be performed, and a ranked listing of trade secrets dependent on those judgments be produced. For a given input, the ranked listing is concrete, determinate and exactly reproducible.

As is generally known, those skilled in the art of evaluating trade secrets would not want and will not use a device that substitutes its own judgment (or its inventors' judgment) for their own. The potential users of Appellant's invention would want their own judgments processed in such a way as to make those judgments more easily considered and compared. For this reason, the scope of Appellant's invention does not include the evaluation process, which is clear from the language of the claims.

Having included the evaluation process in the scope of the invention in contradiction of the claims, the Examiner worries that "There is no proof that the subjective determination made in the human mind can be reliably and predictably quantified" (Examiner's Answer, page 41). On the other hand, the Examiner has offered no proof that a subjective determination made in the context of a trade secret in the human mind cannot be reliably and predictably quantified. In this case, the burden is on the

Examiner and the Examiner has failed to produce any evidence.

Moreover, the five answers to each of the six factors in Table C are generally measurable and quantifiable. Using the first factor of Table C, as an example, the Inside Knowledge of who knows about a trade secret within a company can be easily and objectively verified. The use of a trade secret within a specific subdivision of an organization provides an objective indication of Inside Knowledge. Similar indicators exist for the questions and answers for the other factors of a trade secret in Table C.

In general, the Examiner has failed to provide any rational basis for questioning the objectivity of the inputs in response to Table C. Since each of the answers in Table C is measurable and quantifiable, there is no basis for asserting that the invention does not produce a repeatable or concrete result, even if the evaluative process lies within the scope of the invention, which the claims make clear it does not.

Nor has Examiner offered any argument or evidence that all other questionnaires possible under the first element of the independent claims will fail to elicit objective answers.

With regard to Examiner's undue experimentation objection, quoting from the Examiner's Answer:

> "Applicant states in the related appeal brief that the *applicants expect that, with experience, users will come to an understanding of the threshold values that have [most] meaning within their business environments* (page 26 of the appeal brief for application number 09/757,940). Thus, the Examiner asserts that these statements provide further evidence that the invention is not enabled, nor was it enabled

> at the time of filing, and thus, undue experimentation is needed to make or use the invention." (Examiner's Answer, page 43).

First, Examiner's conclusion here is overbroad. The threshold values appear only in independent claims 119, 121, and 123, and do not provide any evidence one way or the other with respect to the experimentation needed to make or use the invention under the other claims.

Second, a user skilled in the art in the context of the current invention means a user skilled in the art of evaluating trade secrets by other means. The user is further assumed to have some familiarity with the trade secrets entered, as the user had to make evaluative judgments for each trade secret outside the scope of the invention in order to fulfill claim step 2 of each of the independent claims. How much undue experimentation does it take for the user, noticing that a trade secret that in his professional judgment was "iffy" scored a 2.8, and a trade secret that in his professional judgment was "solid" scored a 3.1, to say "Let's set the threshold at 3.0 for now."

Further, the setting of this threshold is once again an evaluative judgment that lies outside of the scope of the invention. The potential users of this system -- skilled judges, lawyers, and engineers -- do not want their judgment on the proper threshold value supplanted by that of the system (or its inventors). The threshold value is another input to the system.

Of course, as users gain experience with the invention, their use of it will become more nuanced, as Appellant noted in the related Appeal Brief. Isn't this to be expected with any invention? Is every user of a patentable invention able to use it to its greatest benefit on first use? If the user obtains strong benefit from using the invention the first time, and the benefits increase over time because his use has become more subtle and nuanced with experience, is the invention therefore unpatentable for requiring undue experimentation?

Appellant therefore asserts that undue experimentation would not be required to use the invention defined by claims 119, 121, and 123, where the user is required to input threshold values, due to the existing ability of users skilled in the art to differentiate the quality of trade secrets by other means.

For all of the above reasons, Examiner's rejection on a lack of enablement to use the invention is therefore incorrect and should be overturned.

New information has become available to the Appellant since the Appeal Brief was filed over six months ago. An embodiment of the invention was constructed using the questionnaire of Table C as directed by the specification and Appendix I, and used to create a ranked listing of the trade secrets at issue in a trade secret misappropriation case currently before a state court. The questionnaire was provided through an output device (printer) to a technical employee of one of the litigants, who provided his

evaluation of the six factors per the questionnaire for over 2500 trade secrets. Entering the 2500 trade secrets into the device was performed by a paralegal in a single week.

The resulting ranked listing of trade secrets was spot checked by experienced trade secret litigators, and the highest-ranking trade secrets were given additional scrutiny. These checks verified that the ranked listing of trade secrets was correct and useful in the litigation. The ranked listing is being used to decide which trade secrets to litigate, simplifying the complex court case and focusing the parties on the major issues.

It should be noted that the person who performed the evaluation was a technical employee, not an attorney, and untrained in the legal definition of trade secrets. The questionnaire and its sample answers of Table C were the only training or guidance given. Further, the person who performed the evaluation was not the ultimate user of the ranked listing, the attorneys involved in the case were. The person entering the information into the machine was a paralegal, not an attorney, and performed data entry only, without any modification of the data.

This method of producing a trade secret listing is to be contrasted with manual methods, which Appellant knows by personal experience can take seasoned trade secret attorneys hundreds of hours to compile in cases of similar complexity. In contrast, this process took one week from the collection of the evaluative judgment, and required no attorney time at all.

While it is too late in the application process for the Appellant to provide a sworn affidavit as to these facts, there is no benefit to Appellant to introduce into the record for this application any untrue facts that could be a basis for future hearing to invalidate any resulting patent. This experience provides further evidence that Examiner's objection on enablement grounds is incorrect and should be overturned.

The nub and crux of Examiner's argument for this rejection appears on page 40 of the Examiner's Answer:

> "Thus, the Examiner asserts that no matter how exacting the six factors are, the subjective analysis as to these six factors render applicant's invention non-repeatable and non-predictable."

This is the core issue underlying the rejection of the application under 35 USC §112. The core issues before the Board with regard to this rejection are:

1) Is any invention that operates, in a well-defined and deterministic way, on user input unpatentable for failing to produce a concrete or tangible or reproducible or useful result because the output depends on the input?

2) Is there a lack of enablement in any invention whose output depends on the user input, despite an objective and deterministic processing of that input within the scope of the invention, for failure to achieve a uniform output across multiple users?

3) Does the ranking on the well-known, common-sense scale from 1 to 5 of the well-defined traits of a trade secret, which have been refined over sixty years of precedent and experience, or of the generated metric require any further explication in the specification in order to meet the enablement requirement?

Appellant asserts that the correct answers to these questions leave Examiner's argument for rejection on these grounds without foundation. The device would provide different outputs for different input by different users, as it is the aggregation of the user's judgment that is the desired output of the device. Making these subjective judgments on a 1 to 5 scale is well within the abilities of those skilled in the art of evaluating trade secrets, even without the textual answers provided in Table C of the specification on pages 20-22. Similarly, understanding the numerical score, which results in a value between 1 and 5, is also well within the abilities of those skilled in the art. Examiner's argument for rejection on these grounds is therefore inapposite and incorrect and should be overturned.

The reader's attention is now directed to the rejection of Claims 1-70 and 119-123 under 35 USC §101. In the argument for rejection in the Examiner's Answer, Examiner relies upon two exclusive formulations of Appellant's invention. Examiner first argues that the invention includes the evaluative judgments of the users on the six factors: "clearly these determinations are not

outside of the claimed invention and thus are relevant in making any determinations as to the patentability of the claimed invention" (Examiner's Answer, page 46). Applying further analysis in the same argument, Examiner asserts Appellant's invention includes nothing more than the calculation of a geometric mean: "Examiner asserts the appellant's invention is nothing more than a mathematical formula used to provide a ranking...." (Examiner's Answer, page 54) Further along, Examiner reverts to the earlier formulation: "The subjective component of appellant's invention is not amenable to reproducibility of a result" (Examiner's Answer, page 57).

The first and third assertions are exclusionary of the second, and cannot all be logically applied at different points in developing the same argument.

Further, neither of these formulations is the Appellant's invention as defined by the claims.

The Appellant's invention is a method for creating a ranked listing of trade secrets through, inter alia, the steps of providing a questionnaire based on the six factors of a trade secret, receiving the answers, applying numeric values, calculating a metric, and ranking the results.

For the first and third of Examiner's assertions to be correct, the invention must include an evaluative process that lies outside the scope of the claim language. Appellant does not claim the evaluative process as part of the invention. The claim

language of the independent claims does not read on the evaluative process, and Examiner's assertion in the first part of the argument for rejection on these grounds, "clearly these determinations are not outside of the claimed invention", is incorrect, as is the "subjective component of appellant's invention" in the third part of the argument.

Furthermore, as discussed above, even if the "subjective component of applicant's invention" were a part of the claimed invention (which it is not), the Examiner has failed to provide any basis that selecting answers in the context of Table C is subjective and not reproducible. Alternatively, Examiner's "subjective component" is based upon measurable and quantifiable data with a repeatable and concrete output.

For the second of Examiner's assertions to be correct, the invention must not include provision of a questionnaire based on the six factors of a trade secret, receiving the answers, and applying numerical scores. Appellant explicitly claims these steps as integral parts of the invention. The claim language of the independent claims clearly includes these steps, and Examiner's assertion in the second part of the same argument for rejection on these grounds, "appellant's invention is nothing more than a mathematical formula used to provide a ranking", is incorrect.

Either of Examiner's formulations is proven inapposite by the claim language, and Examiner's argument fails. Further, using both of these exclusionary formulations in different steps of the

same argument is a logical failure that renders the argument invalid.

The nub and crux of Examiner's argument for this rejection appears on pages 63-64 of Examiner's Answer: "Because each user is making a subjective analysis and entering the numerical score values based on this subjective analysis, any metric produced using these values and any ranking resulting from the use of the metric would not be concrete since it is hard to reproduce another's subjective determination."

This is the core issue underlying the rejection of the application under 35 USC §101. The core issues before the Board with regard to this rejection are:

1) Is any invention that operates, in a well-defined and deterministic way, on user input unpatentable for failing to produce a concrete or tangible or reproducible or useful result because the output depends on the input?

2) Is any invention that uses a mathematical formula as one of its claim steps unpatentable as merely "a novel and useful mathematical formula", irrespective of the other claim steps?

3) Does the output of the invention, a listing which ranks trade secrets on the familiar, common-sense scale from 1 to 5, require any further explication in the specification in order to be considered a useful and concrete result?

4) Must the claim language be strictly read in determining the patentability of an invention, so as to include all

elements on which the claims read and exclude all elements on which the claims do not read?

Appellant asserts that the correct answers to these questions leave Examiner's argument for rejection on these grounds without foundation. The Examiner is arguing against patentability based upon what the Examiner considers the gist of the invention, rather than the invention defined by the claim language. Examiner's argument for rejection on these grounds is therefore inapposite and should be overturned.

The reader's attention is now directed to the rejection of Claims 8-31, 49-56 and 69 under 35 USC §101 for claiming a human being. In particular, "The Examiner asserts that the user is the means for performing the function disclosed in claims 8-31, 49-56, and 59" (Examiner's Answer, page 64).

However, the Examiner's position ignores the most basic of concepts of claim language. More to the point, claims 8-31, 49-56 and 69 depend upon claim 1, and claim 1 is drawn to a programmed computer. Dependent claims, by their very nature, further limit the independent claim and claim 1 is limited to a programmed computer. Since claim 1 is limited to a programmed computer, then so to are dependent claims 8-31, 49-56 and 69. As such, the Examiner's position is not supported and should be overturned.

The reader's attention is now directed to the rejection of Claims 1, 3-35, 37-39, 43, 44, 47-57, 60-63, 67-70 and 121 under 35 USC §102(e) as being anticipated by Donner. In the Examiner's Answer (page 65), the Examiner asserts that "The questionnaire is data displayed on a screen."

Here again, the Examiner reverts to what the Examiner considers to be the gist of the invention. Rather than data, independent claims 1 and 121 are limited to "means within the programmed computer for providing a predetermined criteria for evaluating a potential trade secret." 35 U.S.C. §112, par. 6 states that "An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." Table C of the specification provides a specific example of structure that defines the predetermined criteria. The predetermined criteria of Table C is structurally divided into the six factors of a trade secret. The predetermined criteria is also structurally divided in this embodiment into a structural criteria for selecting one of five possible answers for each of the six factors, each with the structural basis for selecting one answer over another.

The Examiner asserts that "the Examiner looks at the structure defined in the claim language and whether the prior art

has the capability of performing the steps that the applicant claims" (Examiner's Answer, page 65). However, this statement, again, establishes that the Examiner is clearly ignoring the structural content of the predetermined criteria defined in the specification.

Even reduced to its most elemental basis, the display of the questionnaire on a screen still remains physical structure. Moreover, the words and phrases of the questionnaire are functionally related to the structures of the claimed invention because the words and phrases elicit the responses received by the "means . . . for receiving."

Examiner merely repeats the assertions of the Final Rejection in the Examiner's Answer, dismissing the content of the questionnaire as non-functional descriptive data. Examiner repeats the references to the cases of In re Gulack and In re Lowry without argument. Appellant's arguments in the Appeal Brief to the contrary, and in particular appellant's discussion of In re Gulack and In re Lowry as well as In re Miller on which they depend, are not addressed at all. The Board is directed to Appellant's discussion in the Appeal Brief.

Appellant's arguments in the Appeal Brief with regard to this rejection on obviousness grounds thus remain completely unaddressed in Examiner's Response.

The core issues before the Board with regard to this rejection are:

1) Must the claim language be strictly read in determining the patentability of an invention, so as to include all elements on which the claims read?

2) Does the questionnaire's reliance on the six factors of a trade secret from the Restatement (First) of Torts, in order to produce the useful result of a ranked listing of trade secrets per the user's evaluation of those criteria, meet the functional relationship test of Miller?

Appellant asserts that the correct answers to these questions leave Examiner's argument for rejection on these grounds without foundation. The Examiner has discarded structure and/or functional claim language and ignored the importance and differentiation of claim elements in finding Appellant's invention unpatentable. Examiner's rejection on these grounds is therefore incorrect and should be overturned.

The reader's attention is now directed to the rejection of claims 1-41, 43, 44, 47-57, 60-63, 67-70 and 121 under 35 U.S.C. §102(e) as being anticipated by Eder. However, the Examiner once again ignores the limitations of the claims (e.g., "means . . . for providing a predetermined criteria") and the fact that the means for providing the predetermined criteria would also include the "predetermined criteria." Moreover, even assuming that the questionnaire is not structure (which it is), the criteria is functionally related because it elicits the response received by

the "means . . . for receiving."

Examiner merely repeats the assertions of the Final Rejection in the Examiner's Answer, dismissing the content of the questionnaire as non-functional descriptive data. Examiner repeats the references to the cases of In re Gulack and In re Lowry without argument. Appellant's arguments in the Appeal Brief to the contrary, and in particular appellant's discussion of In re Gulack and In re Lowry as well as In re Miller on which they depend, are not addressed at all. The Board is directed to Appellant's discussion in the Appeal Brief.

Appellant's arguments in the Appeal Brief with regard to this rejection on obviousness grounds thus remain completely unaddressed in Examiner's Response.

The core issues before the Board with regard to this rejection are:

1) Must the claim language be strictly read in determining the patentability of an invention, so as to include all elements on which the claims read?

2) Does the questionnaire's reliance on the six factors of a trade secret from the Restatement (First) of Torts, in order to produce the useful result of a ranked listing of trade secrets per the user's evaluation of those criteria, meet the functional relationship test of Miller?

Appellant asserts that the correct answers to these questions leave Examiner's argument for rejection on these grounds

without foundation. The Examiner has discarded structure and/or functional claim language and ignored the importance and differentiation of the claim elements in finding Appellant's invention unpatentable. Examiner's rejection on these grounds is therefore incorrect and should be overturned.

The reader's attention is now directed to the rejection of claims 42, 45, 46, 58, 59, and 64-66 under 35 U.S.C. §103(a) as being obvious over Donner in view of Eder and Haber et al. However, the Examiner once again ignores the limitations of the claims (e.g., "means . . . for providing a predetermined criteria") and the fact that the means for providing the predetermined criteria would also include the "predetermined criteria." Moreover, even assuming arguendo that the questionnaire is not structure (which it is) the criteria is functionally related because it elicits the response received by the "means . . . for receiving."

Examiner merely repeats the assertions of the Final Rejection in the Examiner's Answer, dismissing the content of the questionnaire as non-functional descriptive data. Examiner repeats the references to the cases of In re Gulack and In re Lowry without argument. Appellant's arguments in the Appeal Brief to the contrary, and in particular appellant's discussion of In re Gulack and In re Lowry as well as In re Miller on which they depend, are not addressed at all. The Board is directed to Appellant's

discussion in the Appeal Brief.

Appellant's arguments in the Appeal Brief with regard to this rejection on obviousness grounds thus remain completely unaddressed in Examiner's Response.

The core issues before the Board with regard to this rejection are:

1) Must the claim language be strictly read in determining the patentability of an invention, so as to include all elements on which the claims read?

2) Does the questionnaire's reliance on the six factors of a trade secret from the Restatement (First) of Torts, in order to produce the useful result of a ranked listing of trade secrets per the user's evaluation of those criteria, meet the functional relationship test of Miller?

Appellant asserts that the correct answers to these questions leave Examiner's argument for rejection on these grounds without foundation. The Examiner has discarded structure and/or functional claim language and ignored the importance and differentiation of claim elements in finding Appellant's invention unpatentable. Examiner's rejection on these grounds is therefore incorrect and should be overturned.

The reader's attention is now directed to the rejection of claims 2, 40 and 42 under 35 U.S.C. §103(a) as being obvious over Donner in view of Eder. However, the Examiner once again

ignores the limitations of the claims (e.g., "means . . . for providing a predetermined criteria") and the fact that the means for providing the predetermined criteria would also include the "predetermined criteria." Moreover, even if the questionnaire is not structure (which it is) the criteria would still be functionally related because it elicits the response received by the "means . . . for receiving."

Examiner merely repeats the assertions of the Final Rejection in the Examiner's Answer, dismissing the content of the questionnaire as non-functional descriptive data. Examiner repeats the references to the cases of In re Gulack and In re Lowry without argument. Appellant's arguments in the Appeal Brief to the contrary, and in particular appellant's discussion of In re Gulack and In re Lowry as well as In re Miller on which they depend, are not addressed at all. The Board is directed to Appellant's discussion in the Appeal Brief.

Appellant's arguments in the Appeal Brief with regard to this rejection on obviousness grounds thus remain completely unaddressed in Examiner's Response.

The core issues before the Board with regard to this rejection are:

1) Must the claim language be strictly read in determining the patentability of an invention, so as to include all elements on which the claims read?

2) Does the questionnaire's reliance on the six factors

of a trade secret from the Restatement (First) of Torts, in order to produce the useful result of a ranked listing of trade secrets per the user's evaluation of those criteria, meet the functional relationship test of Miller?

Appellant asserts that the correct answers to these questions leave Examiner's argument for rejection on these grounds without foundation. The Examiner has discarded structure and/or functional claim language and ignored the importance and differentiation of the claim elements in finding Appellant's invention unpatentable. Examiner's rejection on these grounds is therefore incorrect and should be overturned.

The reader's attention is now directed to the rejection of claims 119, 120, 122 and 123 under 35 U.S.C. §103(a) as being obvious over Spencer in view of Barney. However, the Examiner once again ignores the limitations of the claims (e.g., "means . . . for providing a predetermined criteria") and the fact that the means for providing the predetermined criteria would also include the "predetermined criteria." Moreover, even assuming that the questionnaire is not structure (which it is) the criteria would still be functionally related because it elicits the response received by the "means . . . for receiving."

Examiner merely repeats the assertions of the Final Rejection in the Examiner's Answer, dismissing the content of the questionnaire as non-functional descriptive data. Examiner repeats

the references to the cases of In re Gulack and In re Lowry without argument. Appellant's arguments in the Appeal Brief to the contrary, and in particular appellant's discussion of In re Gulack and In re Lowry as well as In re Miller on which they depend, are not addressed at all. The Board is directed to Appellant's discussion in the Appeal Brief.

Appellant's arguments in the Appeal Brief with regard to this rejection on obviousness grounds thus remain completely unaddressed in Examiner's Response.

The core issues before the Board with regard to this rejection are:

1) Must the claim language be strictly read in determining the patentability of an invention, so as to include all elements on which the claims read?

2) Does the questionnaire's reliance on the six factors of a trade secret from the Restatement (First) of Torts, in order to produce the useful result of a ranked listing of trade secrets per the user's evaluation of those criteria, meet the functional relationship test of Miller?

Appellant asserts that the correct answers to these questions leave Examiner's argument for rejection on these grounds without foundation. The Examiner has discarded structure and/or functional claim language and ignored the importance and differentiation of the claim elements in finding Appellant's invention unpatentable. Examiner's rejection on these grounds is

therefore incorrect and should be overturned.

While Examiner spends considerable time in the various Office Actions and in the Examiner's Answer arguing the obviousness of the geometric mean, to which Appellant has had to respond, such arguments are off-point with regard to the current invention. The geometric mean is but one of two example mathematical functions noted in the specification that can be used to calculate a metric for trade secrets within the scope of the invention.

In fact, Appellant seeks patent protection for the process of providing a questionnaire based on the six factors, receiving answers, applying numeric values, calculating a metric, and ranking the trade secrets irrespective of the particular mathematical function used. The function used could be the arithmetic mean or the geometric mean, as disclosed in the specification as examples. The function used could also be a simple summing or a simple product or more complicated functions, such as weighted linear or quadratic equations, and still lie within the scope of the invention.

Appellant asserts that it is novel, useful, and non-obvious to provide numeric values in response to questions based on the six factors from the Restatement (First) of Torts, to calculate a metric *by any mathematical or logical means whatsoever*, and then rank the trade secrets based on this metric.

Ranking various physical items by calculating a numeric score for each item from constituent scores for various attributes is

known in other, unrelated fields. Car magazines rank cars by calculating an overall score from constituent scores in the areas of safety, comfort, performance, handling and the like, and Consumer Reports magazine has made a science of ranking various consumer goods, including cars, by calculating an overall score from constituent scores relevant for each product.

Ranking various non-physical items by calculating a numeric score from constituent scores is less common, but is practiced in some areas, including the evaluation of RFPs as disclosed by the Spencer patent that Examiner cites.

Such methods have never been applied to trade secrets. Some methods designed for and disclosed primarily with regard to ranking patents have made broad statements asserting their application to the broader category of intellectual property, and may even have mentioned trade secrets in passing, but there is no prior art for applying such a method specifically and only to trade secrets.

Further, the basis for the questions is crucial. Appellant's invention bases the questions on the six factors from Section 757 of the Restatement (First) of Torts. There is no prior art for such a basis. Examiner cites no prior art for reliance on the six factors, and must disregard the critical role of the six factors in Appellant's invention as "non-functional descriptive data" in order to argue rejection on obviousness grounds.

Finally, the CAFC in Gulack, cited by the Examiner, noted that it was not only the difference of the content, but the manner in

which the content was determined that made Gulack non-obvious. Examiner's rejection in Gulack, based on a determination that the content of the printed matter was "non-functional descriptive data", was overturned.

So here, it is not just the content of the questionnaire -- reliance on the six factors - that is novel, but that the manner in which the content was determined -- reliance on the legal formulation of what constitutes a trade secret -- and used that further renders Appellant's invention non-obvious in light of the prior art, including the Spencer patent cited by Examiner. In particular to Spencer, there is no legal formulation of what constitutes an acceptable RFP, and so the content cannot be determined in the same manner as in Appellant's invention.

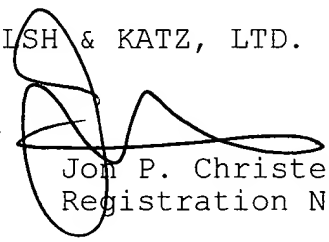
It is compelling that over 60 years had passed from the publication of the Restatement (First) of Torts to the filing of Appellant's first provisional application, without anyone applying numerical scores to the six factors of a trade secret. Despite the increasing importance of trade secrets in the economy, despite the growing use of numerical scores to rank everything from pickup trucks to toaster ovens, in six decades no one thought to apply numerical scores to trade secrets based on the six factors until Appellant.

Such an application of numerical scoring to the six factors of a trade secret thus is not obvious, except in the perfect vision of hindsight.

For the foregoing reasons, allowance of claims 1-70 and 119-123, as now presented, is believed to be in order. It is respectfully requested that this Board reverse the decision of the Examiner in all respects.

Respectfully submitted,

WELSH & KATZ, LTD.

By 

Jon P. Christensen
Registration No. 34,137

June 25, 2007
WELSH & KATZ, LTD.
120 South Riverside Plaza
22nd Floor
Chicago, Illinois 60606
(312) 655-1500